

REMARKS

Applicants hereby traverses the outstanding rejections, and requests reconsideration and withdrawal in light of the remarks contained herein. Claims 1-20 are pending in this application.

Rejection under 35 U.S.C. § 103(a)

Claims 1-20 are rejected under 35 U.S.C. § 103(a) as being obvious over Pearce et al. ('534, hereinafter Pearce) in view of Chew ('560).

It appears that the Examiner has made two separate rejections. In the first, the Examiner appears to be rejecting the claims over Pearce alone. In the second, the Examiner appears to be rejecting the claims over Pearce in view of Chew.

With regards to the first rejection, Applicants note that to establish a prima facie case of obviousness, three basic criteria must be met. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art to modify the reference or to combine reference teachings. Second, there must be a reasonable expectation of success. Finally, the prior art cited must teach or suggest all the claim limitations. See M.P.E.P. § 2143. Without conceding the second and third criteria, Applicant asserts that the rejection does not satisfy the third criteria.

The Examiner has stated that Pearce does not teach having a real mode driver. The Examiner then states that Pearce discloses various teachings. Next the Examiner states:

“Therefore, it would have been obvious ... to realize the Pearce’s computer system comprising device drivers used for computer devices to communicating [sic] with computer system as well as USB service routine used for communication between USB controller an [sic] external devices as being the real mode driver operable to enable communication between the computer application and USB storage device as claimed by Applicant. This is because the Pearce’s USB driver (i.e. a real-mode driver) has to be employed within the computer system in order for computing devices to communicating [sic] with USB application under certain computer operating system [sic]. By utilizing this approach, data

can be transferred in real time process [sic] under debugging, data recovery, or normal operation via USB means...”

It appears that the Examiner is attempting to formulate a rejection based on inherency. In order to properly establish a rejection based on inherency, “the Examiner must provide a basis in fact and/or technical reasoning to reasonably support the determination that the allegedly inherent characteristic necessarily flows from the teachings of the applied prior art,” M.P.E.P. § 2112, citing Ex parte Levy, 17 USPQ2d 1461, 1464 (Bd. Pat. App. & Inter. 1990) (emphasis original). However, the Examiner’s statements do not support the assertion that Pearce inherently teaches a real-mode device driver. None of the statements provide any basis for Pearce to be operating in a real mode. Furthermore, there is no disclosure in Pearce, either explicit or implicit that teaches that Pearce is operating in a real mode. The Examiner has not provided a source for such a teaching. Therefore, rejection of Applicants believe that the limitation of “real mode” in combination with other limitations, clearly distinguishes claims 1, 6, and 14 , and thus their respective dependent claims, from this rejection.

With regards to the second rejection, Applicants believe that the Office Action does not comply with the mandates of *Graham v. John Deere*. The test for non-obvious subject matter is whether the differences between the subject matter and the prior art are such that the claimed subject matter as a whole would have been obvious to a person having ordinary skill in the art to which the subject matter pertains. The United States Supreme Court in *Graham v. John Deere and Co.*, 383 U.S. 1 (1966) set forth the factual inquiries which must be considered in applying the statutory test: (1) determining of the scope and content of the prior art; (2) ascertaining the differences between the prior art and the claims at issue; (3) resolving the level of ordinary skill in the pertinent art, and (4) evaluate evidence of secondary considerations. See M.P.E.P. § 2141.

The M.P.E.P. § 706.02(j), incorporates the mandate of *Graham v. John Deere* and directs the Examiner to set forth in the Office action: (1) the relevant teachings of the prior art relied upon; (2) the difference or differences in the claim over the applied references; (3) the proposed modification of the applied references necessary to arrive at the claimed subject

matter; and (4) an explanation why one of ordinary skill in the art at the time the invention was made would have been motivated to make the proposed modification.

The rejection of claims 1-20, as stated in the Office Action, does not describe the relevant teachings of the prior art. The Examiner has stated that Pearce does not teach having a real mode driver. The Examiner then cites Chew as teaching a system and method for testing a USB application comprising a test application and a test application driver; a USB interpreter comprising test application and driver used for communication between computer system and devices; and a USB interpreter used for debugging. None of the cited teachings of Chew are purported to teach a real mode driver.

Therefore the rejection of claims 1-20 under 35 U.S.C. § 103 is improper and should be withdrawn, and claims 1-20 should be indicated as allowable over the prior art of record.

With further regards to the second rejection, Applicants note that to establish a prima facie case of obviousness, three basic criteria must be met. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art to modify the reference or to combine reference teachings. Second, there must be a reasonable expectation of success. Finally, the prior art cited must teach or suggest all the claim limitations. See M.P.E.P. § 2143. Without conceding the second and third criteria, Applicant asserts that the rejection does not satisfy the first and third criteria.

The Office Action admits that Pearce does not teach having a real mode driver. The Office Action attempts to cure this deficiency by introducing Chew. The motivation for making the combination was presented as follows:

“one would modify the Pearce [sic] to explicitly including [sic] the USB interpreter comprising [sic] test application and a test application driver used for communication between [sic] computer system and devices as taught by Chew in supporting the computer application data exchanging and storage via USB functionality.”

The Examiner then goes on to state:

“this modification would have been obvious because a person having ordinary skill in the art would have been motivated to do so to provide the system processor based function with a USB mechanism to enhance the communication between computer application and computing devices (i.e., peripheral communication devices, such as USB storage device). That is by performing data exchanging between or among computing devices, the computer system can execute applications for testing, debugging, data failure detection and recovery process.”

It is well settled that the fact that references can be combined or modified is not sufficient to establish a prima facie case of obviousness, M.P.E.P. § 2143.01. Applicant notes that Pearce already has a USB functionality or USB mechanism, i.e. the USB controller 501. The USB controller facilitates communication between auxiliary devices 527, 531, and system 500. Therefore, the cited motivation to combine is duplicitous with respect to the teaching of Pearce. Thus, the language of the cited motivation is merely a statement that the reference can be modified, and does not state any desirability for making the modification. The mere fact that references can be combined or modified does not render the resultant combination obvious unless the prior art also suggests the desirability of the combination. In *re Mills*, 916 F.2d 680, 16 USPQ.2d 1430 (Fed. Cir. 1990), as cited in M.P.E.P. § 2143.01. Thus, the motivation provided by the Examiner is improper, as the motivation must establish the desirability for making the modification.

No valid suggestion has been made as to why a combination of Pearce and Chew is desirable. Therefore, the rejection of claims 1-20 should be withdrawn.

The Office Action admits that Pearce does not teach having a real mode driver. The Office Action attempts to cure this deficiency by introducing Chew. However, this combination, as presented, does not teach or suggest all limitations of the claimed invention.

Claims 1, 6, and 14 includes the words “real mode”. Pearce does not teach a “real mode”. Nothing in the Office Action provides any support that Pearce teaches a “real mode”. Furthermore, Chew is not relied upon as teaching “real mode” and nothing in Chew appears to teach a “real mode”. Therefore, the Applicants respectfully assert that for the above reasons claims 1, 6, and 14 are patentable over the 35 U.S.C. § 103(a) rejection of record.

Claims 2-5, 7-13, and 15-20 depend from base claims 1, 6, and 14, respectively, and thus inherit all limitations of their respective base claims. Each of claims 2-5, 7-13, and 15-20 sets forth features and limitations not recited by the combination of Pearce and Chew. Thus, the Applicants respectfully assert that for the above reasons claims 2-5, 7-13, and 15-20 are patentable over the 35 U.S.C. § 103(a) rejection of record.

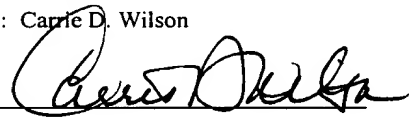
In view of the above, each of the presently pending claims in this application is believed to be in immediate condition for allowance. Accordingly, the Examiner is respectfully requested to pass this application to issue.

Applicant believes no fee is due with this response. However, if a fee is due, please charge Deposit Account No. 08-2025, under Order No. 10991037-1 from which the undersigned is authorized to draw.

I hereby certify that this correspondence is being deposited with the U.S. Postal Service as Express Mail, Airbill No. EV482737144US, in an envelope addressed to: MS Amendment, Commissioner for Patents, PO Box 1450, Alexandria, VA 22313-1450, on the date shown below.

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